

REMARKS

Claims 3, 5, 9, 14-16, and 18-19 have been amended herein. Claims 27-29 have been added. Claims 1-29 are now pending in the Application. No new matter has been added. Entry of the amendments is respectfully requested. Reconsideration is respectfully requested.

Allowed Claim

Claims 16 and 17 were not rejected. The allowance of claims 16 and 17 is greatly appreciated.

Amendments to Drawings/Specification

In the Action the Drawings were objected to because the lines, numbers, and letters were not uniformly thick and well defined. Replacement drawing sheets have been provided. No new matter has been added. It is respectfully submitted that this amendment obviates the objection.

In addition, the Specification has been amended to correct inadvertent misspellings of gunwale as gunnel on page 10, to clarify the use of shoulder(s) and shoulder portion(s), and to correct inadvertent errors in reference numerals on page 29. No new matter has been added.

Claim Objections

In the Action claims were objected as dependent on a rejected base claim but containing allowable subject matter. These objections are respectfully traversed.

Subject Matter Indicated To Be Allowable

It was indicated in the Action that claims 5, 6, 9-11, 15, and 19-24 were objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form. Even though the Applicant believes all claims to be allowable as originally submitted, the objected to dependent claims have been rewritten in independent form, or now depend from an allowable claim. Specifically, Claims 5, 9, 15, and 19 have been rewritten in independent form and include all the material limitations of the original base claims. Claims 6, 10-11, and 20-24 each depend from one of the amended independent claims. It is respectfully submitted that pending claims 5, 6, 9-11, 15, and 19-24 are allowable.

Amendments to Claims

In addition to rewriting the claims in independent form those claims that were indicated to be allowable, the claims have been amended herein to correct an inadvertent misspelling of gunwale as gunnel in Claims 3, 16, and 18. The change these claims are intended to enhance clarity and definiteness of the claims and do not alter the scope of the claims.

The Pending Claims Are Not Anticipated or Obvious in View of the Applied Art

Claims 1, 2, 7, 8, and 12 were rejected under 35 U.S.C. § 102(b) as being anticipated by Thibodou, U.S. Patent 1,609,330 (“Thibodou”).

Claims 3, 4, 14, 18, and 25 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Thibodou.

These rejections are respectfully traversed.

Applicant respectfully submits that each of these claims recites features which patentably distinguish over the prior art.

Brief Description of the Invention

The present invention is directed to a clamp comprised of two clamping parts. Clamping functionality is derived from the shape of the two clamping parts in relation to each other and to the gunwale of a boat, not primarily from tensioning devices. In an exemplary embodiment of the invention, the apparatus includes two roughly hook shaped clamp parts which each have a shoulder and an elongated nose part which extends adjacent the shoulder portion. When placed together around the gunwale of a boat, the nose part of one clamp part rests on or near the shoulder portion of the other clamp part, forming a keyhole aperture which fits snugly around the gunwale and upper hull of the boat. The nose to shoulder relationship of the clamp parts, and the presence of the gunwale in the larger portion of the keyhole aperture, prevents the clamp parts from rotating about the gunwale with respect to each other, thereby preventing the clamp from releasing its hold or crimping the gunwale or hull of the boat.

**The Applied References Do Not Disclose or Suggest
the Features and Relationships Recited in Applicant's Claims**

Anticipation pursuant to 35 U.S.C. § 102 requires that a single prior art reference contain all the elements of the claimed invention arranged in the manner recited in the claim. *Connell v. Sears, Roebuck & Co.*, 722 F.2d 1542, 1548, 220 USPQ 193, 198 (Fed. Cir. 1983).

Anticipation by inherency requires that the Patent Office establish that persons skilled in the art would recognize that the missing element is necessarily present in the reference. To establish inherency the Office must prove through citation to prior art that the feature alleged to be inherent is “necessarily present” in a cited reference. Inherency may not be established based on probabilities or possibilities. It is plainly improper to reject a claim on the basis of 35 U.S.C. § 102 based merely on the possibility that a particular prior art disclosure could or might be used or operated in the manner recited in the claim. *In re Robertson*, 169 F.3d 743, 49 U.S.P.Q. 2d 1949 (Fed. Cir. 1999).

Before a claim may be rejected on the basis of obviousness pursuant to 35 U.S.C. § 103, the Patent Office bears the burden of establishing that all the recited features of the claim are known in the prior art. This is known as *prima facie* obviousness. To establish *prima facie* obviousness, it must be shown that all the elements and relationships recited in the claim are known in the prior art. If the Office does not produce a *prima facie* case, then the Applicant are under no obligation to submit evidence of nonobviousness. MPEP § 2142.

The teaching, suggestion, or motivation to combine the features in prior art references must be clearly and particularly identified in such prior art to support a rejection on the basis of obviousness. It is not sufficient to offer a broad range of sources and make conclusory statements. *In re Dembiczak*, 50 USPQ2d 1614, 1617 (Fed. Cir. 1999).

The evidence of record must teach or suggest the recited features. An assertion of basic knowledge and common sense not based on any evidence in the record lacks substantial evidence support. *In re Zurko*, 258 F.3d 1379, 59 USPQ2d 1693 (Fed. Cir. 2001).

It is respectfully submitted that the Action does not meet these burdens.

The Thibodou Reference

Thibodou is directed to a standard boat clamp in which a tensioning device creates substantially all of the clamping functionality.

The Features Recited in Applicant's Claims Patentably Distinguish Over Thibodou

In the Action claims 1, 2, 7, 8, and 12 were rejected under 35 U.S.C. § 102(b) as being anticipated by Thibodou. These rejections are respectfully traversed. Applicant's response to these rejections is based on the Office's referenced interpretation of Thibodou. Thus, any change in the Office's interpretation of Thibodou shall constitute a new ground of rejection.

The Action alleges that Thibodou discloses an apparatus comprising a first clamp part, and a second clamp part, with the first clamp part having “one nose and two shoulders” and a second clamp part having “two noses and a shoulder between the two noses,” with a “pintle 24 passing through the noses and the shoulders receiving the noses”. The Action suggests that these elements anticipate independent Claim 1.

Applicant disagrees. These rejections are respectfully traversed on the grounds that the Thibodou reference does not contain all the elements of the claimed invention arranged in the manner recited in the claims. The features and relationships recited in Applicant’s claims patentably distinguish over the Thibodou reference.

Claim 1

Claim 1 is an independent claim which is specifically directed to method. It is respectfully submitted that Thibodou does not disclose a method, but an apparatus. The Action did not identify the steps of the method of Claim 1 which are taught by Thibodou. Such steps are not set out in Thibodou. The Action did allege or cite to any prior art for the principle that the untaught steps are inherently present in the Thibodou apparatus. Furthermore, applicant respectfully suggests that the steps of the method in Claim 1 are not inherent based on the Thibodou apparatus and are, furthermore, impossible to perform using the Thibodou apparatus without destroying the functionality of the Thibodou apparatus.

Claim 1 recites fastening two clamp parts together including as part of the fastening step placing a nose part of the first clamp part adjacent a shoulder portion of the second clamp part and placing a nose part of the second clamp part adjacent a shoulder portion of the first clamp part. The Office has identified a single nose part in the first clamp part of the Thibodou apparatus. That nose part is adjacent and fastened to a first nose part in the second clamp part. Further, it is not fastened to the shoulder portion of each as suggested in the Action. The nose part of the first clamp part is not placed adjacent the single shoulder portion in the second clamp part of Thibodou, as identified by the Office. Were it to be placed adjacent the shoulder portion of the second clamp part, the holes in the nose parts would no longer be aligned and could not remain fastened by the pintle, which fastening is essential to the function of the Thibodou clamp.

The nose part of the second clamp part (joined to the nose part of the first clamp part) is not placed adjacent either shoulder portion of the Thibodou first clamp part as identified in the Action. Were it to be placed adjacent either shoulder portion of the first clamp part, the holes in the nose parts would no longer be aligned and could not remain fastened by the pintle, which fastening is essential to the function of the Thibodou clamp. With respect to the second nose part of the second clamp part, in order to function the second nose part of the second clamp part of the Thibodou clamp must be placed adjacent the gunwale, not adjacent another clamp part.

In addition, the Thibodou clamp is described as a “hinged jaw.” Nothing in the Thibodou specification, drawings, or claims suggests that it is comprised of two separate parts which are individually placed and fastened together by strategic arrangement of features of each clamp part

in relation to the other. No relevant fastening step is described in Thibodou, but the Action seems to presume that the corresponding fastening is the hinging between what the Office has identified as nose parts of the separate clamp parts. Because it is the nose parts that are joined, any spatial relationship between the Thibodou shoulder portions of one clamp part and the Thibodou nose part of the other clamp part is solely a consequence of the proximity of the nose part of each clamp part and the shoulder portion of that same part. Such a coincidental relationship is not essential element in a fastening step.

Thibodou does not disclose each and every element of the claimed invention arranged in the manner recited in the claims, as is required to sustain the objection. Hence, Applicant's Claim 1 patentably distinguishes over the Thibodou reference. Therefore, it is respectfully submitted that the 35 U.S.C. § 102(b) rejection has been overcome. It follows that the claims 2, 7, 8, and 12 which depend from Claim 1 are likewise allowable.

The Pending Claims Are Not Obvious Over Thibodou

In the Action claims 3, 4, 14, 18, and 25 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Thibodou. These rejections are respectfully traversed. Applicant response to these rejections is based on the Office's referenced interpretations of Thibodou. Thus, any change in the Office's interpretation of these references shall constitute a new ground of rejection.

Applicant traverses these rejections on the grounds that Applicant's claims recite features and relationships which are neither disclosed nor suggested in the prior art, and because there is no teaching, suggestion, or motivation cited so as to produce Applicant's invention.

Claims 3 and 4

Claims 3 and 4 which were rejected as obvious over Thibodou. Claims 3 and 4 incorporate all of the features and limitations in Claim 1. As discussed above, it is respectfully submitted that Claims 1 is not anticipated by Thibodou. The action did not make a separate suggestion that Claim 1 was obvious in view of Thibodou. Therefore, regardless of whether additional elements or limitations in Claims 3 and 4 are obvious, because there are elements and limitations in the portions of Claims 3 and 4 which are derived from Claim 1 and which are not anticipated by, or obvious in view of, Thibodou, Claims 3 and 4 cannot be anticipated by, or obvious in view of, Thibodou.

Claim 14

Claim 14 is an independent claim which is specifically directed to method. It is respectfully submitted that Thibodou does not disclose a method, but an apparatus. The Office did not identify the steps of the method of Claim 14 which are taught or suggested by Thibodou, nor are such steps set out in Thibodou. The Action did allege or cite to any prior art for the principle that the untaught steps are inherently present in the Thibodou apparatus. Furthermore, applicant respectfully suggests that the steps of the method in Claim 14 are not inherently present in the apparatus recited by the Office and are, furthermore, impossible to perform using the

Thibodou apparatus without destroying its functionality. The features recited in Applicant's claims patentably distinguish over the applied references.

The Action admits that Thibodou does not disclose the following recited feature, "a width of the stem portion [of an aperture] is narrower than the width of the gunnel 18"

The Action alleges that the Thibodou teaches "an aperture including an opening portion that extends around the gunwale wherein the aperture further includes a stem portion formed by jaws 21 and 26 that extends adjacent each side portion of a hull of the boat." It further alleges that Thibodou teaches that "a bolt 28 and tension nut 30 enable one to make the width of the stem portion more narrow than the wi[d]th of the gunnel" and that it would have been obvious to do so "for storage of the attachment of Thibodou."

The Applicant disagrees.

First, the method of Claim 14 is a method for mounting items on a boat, not for storage of an "attachment." The narrower stem of the aperture in Claim 14 exists during use, as an element of the fastening the clamp step. Claim 15 is silent as to the relationship between the dimensions of the stem and the gunwale when it is not used as part of a fastening step.

Making the Thibodou stem narrower than the gunwale is inconsistent with the use of the Thibodou clamp. The jaws, which the Action identifies as forming the stem of the Thibodou

aperture, clamp the gunwale 18 of the boat as described and illustrated in Thibodou. Because the jaws clamp the gunwale of the boat, the suggestion to narrow the aperture so that the stem portion (between the jaws) is narrower than the gunwale teaches away from Thibodou. Such a narrowing would destroy the utility of Thibodou clamp, in that a jaw aperture narrower than the gunwale to which it was clamped would crimp the gunwale and damage the boat. An obviousness rejection cannot be based on a combination of features in references if making the combination would result in destroying the utility or advantage of the device shown in the prior art references. See *In re Fine*, 5 USPQ2d 1598-99 (Fed. Cir. 1988).

Applicant's Claim 14 also teaches that each clamp part includes a "nose part which curves around an uppermost point on the gunwale." The Action suggests that Thibodou teaches a clamp "wherein each clamp part includes a nose which curves around an uppermost point on the gunwale." Nothing in the text of the specification teaches or suggests that the Thibodou clamp is comprised of separate clamp parts each of which curve around an uppermost point on the gunwale. The illustration of the Thibodou clamp in Figure 2, the only drawing which shows the relationship between the clamp parts and the gunwale, shows that only the first clamp part curves around an uppermost point on the gunwale.

The Office has not suggested that it would have been obvious to modify Thibodou so that both clamp parts curved around an uppermost point on the gunwale, nor would it have been obvious from Thibodou to do so. The Thibodou nose parts overlap only in a small area around the pintle. There is no suggestion within Thibodou that changing the position of the overlap

would be useful, as the location of that pintle (or the overlap of the nose parts) in relation to the gunwale is not identified as serving any particular function that would be improved or diminished by virtue of its position in relation to the gunwale.

Applicant respectfully suggests that Thibodou does not suggest the features and relationships that are specifically recited in Claim 14.

Claim 18

Claim 18 is an independent claim which is directed to an apparatus. The Action admits that Thibodou does not disclose an aperture stem which is narrower than the gunwale. Thibodou also lacks other recited features and relationships not noted in the Action. It is respectfully submitted that Thibodou also does not disclose the overlapping relationship between the clamp parts in which the “nose parts of each of the clamp parts . . . contact the shoulder portions” of the other clamp part to which such nose part is adjacent.

With respect to the aperture stem which is narrower than the gunwale, the Action alleges that Thibodou teaches “an aperture including an opening portion that extends around the gunwale wherein the aperture further includes a stem portion formed by jaws 21 and 26 that extends adjacent each side portion of a hull of the boat.” It further alleges that Thibodou teaches that “a bolt 28 and tension nut 30 enable one to make the width of the stem portion more narrow than the wi[d]th of the gunnel,” and that motivation to do so is to bring jaws 21 and 26 into contact or almost in contact with each other for “storage of the attachment of Thibodou.”

The Applicant disagrees.

First, the apparatus of Claim 18 describes a stem portion “extending adjacent each side of a portion of the hull.” Regardless of how the item may be stored, the narrower stem must exist in relation to the hull when the apparatus it is being used as a clamp. The possibility that the stem of the aperture might be narrower than the gunwale when the apparatus is being stored is irrelevant.

Making the Thibodou stem narrower than the gunwale is inconsistent with the use of the Thibodou clamp. The jaws, which the Action identifies as forming the stem of the Thibodou aperture, clamp the gunwale 18 of the boat. Because the jaws clamp the gunwale of the boat, the suggestion to narrow the aperture so that the stem portion (between the jaws) is narrower than the gunwale teaches away from Thibodou. A clamping aperture that is narrower than the gunwale about which it is clamped would destroy the utility of the Thibodou clamp because it would crimp the gunwale and damage the boat.

A reference teaching away from the recited invention does not support *prima facie* obviousness. It is improper to reconstruct the invention from the disclosure of the Applicant. An obviousness rejection cannot be based on a combination of features in references if making the combination would result in destroying the utility or advantage of the device shown in the prior art references. Note *In re Fine*, 5 USPQ2d 1598-99 (Fed. Cir. 1988).

Claim 18 also includes the following additional element and limitations: “The nose part of a first one of the clamp parts extends adjacent the shoulder portion of a second one of the clamp parts [and] the nose part of the second one of the clamp parts extends adjacent the shoulder portion of the first one of the clamp parts. . . to contact the shoulder portions.” The Action did not allege that Thibodou teaches these elements and limitations, nor did it allege that they were obvious in view of Thibodou.

As previously discussed, Thibodou does not teach the interrelationship between the shoulder portion of one clamp part and the nose part of the other. At most, Thibodou teaches the relationship between what the Action identifies as nose parts on each of the clamp parts. Because the shoulder portion elements of the Thibodou clamp are not discussed, nothing in Thibodou suggests that there would be any benefit in modifying the clamp so that each nose part contacts the respective shoulder portion of the other clamp part.

Even if it were somehow possible to modify Thibodou to address the width of the stem, a modified Thibodou would still not disclose or suggest the interrelationship between respective the nose parts and shoulder portions of each clamp part.

As nothing in the cited art discloses nor suggests the features and relationships that are specifically recited in the claim, and because there is no teaching, suggestion or motivation cited for combining features of the cited references so as to produce Applicant’s invention, it is respectfully submitted that the claim is allowable for these reasons. Therefore, it is respectfully

submitted that the 35 U.S.C. § 103(a) rejection should be withdrawn. It follows that the claims which depend from Claim 18 are likewise allowable.

The Dependent Claims

Dependent Claim 25 depends directly or indirectly from an independent claim. The independent claims have been previously shown to be allowable. “If an independent claim is nonobvious under 35 U.S.C. § 103, then any claim depending therefrom is nonobvious” (MPEP 2143.03). *In re Fine*, 5 USPQ2d 1596 (Fed. Cir. 1988). Thus, it is asserted that the dependent claims are allowable on the same basis.

The New Claims

Claim 27 is an independent claim which is directed to method for mounting at least one item to a gunwale of a boat. The claim specifically recites the operational relationship between the nose part of one clamp part and the shoulder portion of a second clamp part.

Claim 28 is an independent claim which is directed to a method for mounting at least one item to a gunwale of a boat. The claim specifically recites the function of the fastener and the operative connection between the aperture and the gunwale of the boat.

Claim 29 is an independent claim which is directed to apparatus for mounting items to a gunwale of a boat. The claim specifically identifies the physical and operational relationship between the clamp parts and the gunwale.

None of the cited references alone or in combination discloses or suggests the features and relationships that are specifically recited in the new claims 27-29. These claims recite features, relationships, and steps recited in the original claims and are allowable for at least the same reasons. As nothing in the cited art discloses nor suggests the features and relationships that are specifically recited in the new claims, and because there is no teaching, suggestion or motivation cited for combining features of the cited references so as to produce Applicant's invention, it is respectfully submitted that the new claims are allowable for these reasons.

Additional Claim Fees

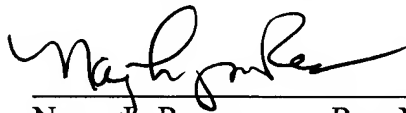
Please charge the fees associated with prosecution of 7 additional independent claims in excess of 3 (small entity - \$308.00) and 4 additional total claims (small entity \$27.00) and any other fee due, to Deposit Account No. 10-0637 of Walker & Jocke.

Conclusion

It is acknowledged that claims 5, 6, 9-11, 15, and 19-24 recite allowable subject matter, but for dependence on rejected base claims. Claims 5, 9, 15, and 19 have been amended herein to be independent claims and should now be allowable. Each of Applicant's pending claims specifically recites features and relationships that are neither disclosed nor suggested in any of the applied art. Furthermore, the applied art is devoid of any such teaching, suggestion, or motivation for combining features of the applied art so as to produce Applicant's invention. Allowance of all of Applicant's pending claims is therefore respectfully requested.

Reconsideration and allowance of all the pending claims is requested. The undersigned will be happy to discuss any aspect of the Application by telephone at the Examiner's convenience.

Respectfully submitted,



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Amendments to the Drawings

To overcome the objections to the drawings noted on Form PTOL-326, replacement drawing sheets are attached hereto for all figures which include lines, numbers, and letters that are uniformly thick and well defined. No new matter has been added. Permission to amend the drawings by substitution is respectfully requested.